

REMARKS

The Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

I. Status of the Claims

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 1, 3, 5 and 8 are currently being amended without prejudice or disclaimer. Support for the amendments can be found throughout the Specification, for example, on Page 3, Lines 12-17. No new matter is added.

Claims 10-12 are added. Support for the new claims can be found throughout the Specification, for example, on Page 3, Lines 21-35 of the Specification and claims 1, 3 and 5. No new matter is added.

Claims 4, 6-7 and 9 are requested to be cancelled without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of the cancelled claim in a continuation application.

After amending the claims as set forth above, claims 1, 3, 5 and 10-12 are now pending to be examined on their merits. Claim 8 remain withdrawn.

II. Information Disclosure Statement

Applicants thank the Examiner for acknowledging the Information Disclosure Statement (IDS) submitted February 12, 2010.

II. Restriction

Applicants confirm the provisional election of Group I (claims 1-7, drawn to a cosmetic composition). Group II (claims 8-9, drawn to a method for providing gloss on lips and moisture feeling by applying the cosmetic composition according to claim 1 or 7) stands withdrawn. Applicants reserve the right to rejoin Group II according to MPEP 821.04. Applicants note that upon allowance of the composition claims, the restriction requirement as to the process of using claims reciting all of the limitations of the allowable composition claims will be rejoined and fully examined for patentability in accordance with 37 C.F.R. 1.104.

Newly submitted claims 10-12 (reciting all limitations of claim 1) should be examined, as they are drawn to a cosmetic composition, more specifically a lipstick composition, encompassing the elected Group I.

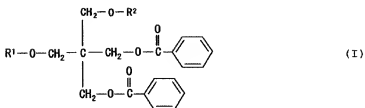
III. Claim Objections

Claim 7 is objected to. Claim 7 is cancelled without prejudice or disclaimer. Accordingly, the objection is now moot.

IV. Claim Rejections - 35 USC § 103

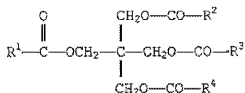
Claims 1-3 and 6-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu (WO 02/19977). Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitsumatsu in view of Healy (WO 00/26285).

The independent claim 1 is amended to recite “a lipstick composition comprising an ester of pentaerythritol and a benzoic acid having the formula (I):



wherein R¹ is a 2-ethylhexanoic acid residue and R² is a benzoic acid residue.”

Mitsumatsu teaches that a hair care composition comprising a genus according to the following formula:



wherein R¹, R², R³ and R⁴, independently are branched, straight, saturated, or unsaturated alkyl, aryl and alkylaryl groups having from 1 to about 30 carbons.

Applicants respectfully traverse the rejections based on Mitsumatsu because a *hair care composition* is *physically different* from a *lipstick composition*. It would not be obvious to one of ordinary skill in the art to interchange a composition for hair care a lipstick composition absent of any specific teaching thereof. A *prima facie* obviousness is not established. To the extent the PTO may not be giving full weight to the preamble of the claims, applicants wish to point out that a preamble must be given weight when it is tied to elements in the claims, such as the “cosmetically acceptable carrier for lipstick” (emphasis supplied) recited in the instant claims. The PTO cannot ignore the fact that a lipstick carrier is physically different from shampoo. In the absence of any suggestion to convert the prior art’s shampoo composition into a lipstick composition, the rejection should be withdrawn.

Additionally, the need for picking and choosing from various compounds of Mitsumatsu's broad genus (having R¹, R², R³ and R⁴, independently being branched, straight, saturated, or unsaturated alkyl, aryl and alkylaryl groups having from 1 to about 30 carbons) is required to reach an embodiment within the scope of the present claims (requiring R¹ being a 2-ethylhexanoic acid residue and R², R³ and R⁴ being a benzoic acid residue), so that the invention

is not squarely described or rendered obvious, especially in view of the comparative results¹ demonstrated in the Specification and the Hosokawa Declarations filed on March 08, 2010 and May 19, 2009. Specifically, as shown in the present Specification and the Hosokawa Declaration dated May 19, 2009, only *tribenzoic acid* ester (see Examples 1 and 2) and *dibenzoic acid* ester (see Experiments A and B) provide characters desired for lipstick compositions. By contrast, *tetra-2-ethylhexanoic acid ester*, which also encompasses Mitsumatsu broad genus, does *not* provide these desired results. In other words, Examples 1 and 2 and Experiments A and B in the Hosokawa Declaration suggest that only the pentaerythritol ester having three benzoic acid residues, as recited in claim 1, can provide characters desired for lipstick compositions including gloss on lips, moisture feeling and cosmetic durability. Nowhere can this be found in Mitsumatsu. Applicants therefore submit that merely disclosing a general genus of pentaerythritol ester oil, Mitsumatsu's teaching does not render obvious the presently claimed compositions, let alone using the compositions for lipstick.

Healy is cited for disclosing other features of dependent claims 4-5, but fails to cure the above-discussed deficiencies of Mitsumatsu.

Claims 3 and 5 depend from claim 1, and thus are patentable for at least the same reasons as claim 1. Claims 2, 4 and 6-7 are cancelled.

Applicants respectfully request withdrawal of the section 103 rejections in view of the above reasons.

IV. New Claims

Newly added claims 10-12 recite lipstick compositions comprising a specific compound of tribenzoic acid-mono-2-ethylhexanoic acid pentaerythritol ester. Applicants respectfully submit that none of cited prior art discloses, teaches or suggests the lipstick compositions

¹ With regard to the objections to the method used for data collecting (e.g., what constitute good or not good gloss), Applicants respectfully submit that the test of "Evaluation of Lipstick Cosmetics" described on Page 7 of the instant application is widely accepted and generally used for the evaluation in the cosmetic field. For example, similar tests have been disclosed US 6063391 (see US 6063391, Column 15, Lines 30-45).

comprising the specific compound recited in claims 10-12. Moreover, claims 10-12 recite all limitations of claim 1, and thus should be patentable for at least the same reasons as claim 1.

V. Conclusion

The Applicants believe that the present application is now in condition for allowance and respectfully request favorable reconsideration of the application.

The Office is invited to contact the undersigned by telephone if a telephone interview would advance the prosecution of the present application.

The Office is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date November 8, 2010

By /Stephen B. Macbius/

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Stephen B. Macbius
Attorney for the Applicants
Registration No. 35,264